

1 Remarks

2 Preliminary Remarks

3 Claims 1-20 are pending in the application. Claims 1 and 12 are amended.  
4 The issues in the application are as follows:

- 5 • Claims 1-2, 5-8, 10-13 and 16-17 have been rejected under 35 U.S.C. §  
6 102(e) as being anticipated by a U.S. Patent Application 6,466,326 to Shima  
7 (hereinafter, "Shima").
- 8 • Claims 3-4, 9 and 14-15 have been rejected under 35 U.S.C. § 103 as being  
9 unpatentable over Shima in view of U.S. Patent Application 5,087,979 to  
10 Schaertel (hereafter, "Schaertel").
- 11 • Claims 18-20 have been rejected under 35 U.S.C. § 103 as being  
12 unpatentable over Schaertel in view of U.S. Patent No. 5,528,734 to Sanchez  
13 (hereafter, "Sanchez").

14 In response, Applicant hereby traverses the outstanding rejections and requests  
15 reconsideration and withdrawal in light of the amendments and remarks contained  
16 herein. Support for the amendments to claims 1 and 12 is provided at least by the  
17 specification at page 4, lines 27-29 and Fig. 1 (element 120).

18 Rejection of Claims under 35 U.S.C. § 102

19 Claims 1-2, 5-8, 10-13 and 16-17 have been rejected under 35 U.S.C. §  
20 102(e) as being anticipated by Shima.

21 The Applicant respectfully disagrees that claims 1 and 12 (as amended), 2, 5-  
22 8, 10-11, 13 and 16-17 are anticipated by Shima.

23 As a starting point, the PTO and the Federal Circuit provide that §102  
24 anticipation requires each and every element of the claimed invention to be  
25 disclosed in a single prior art reference. (*In re Spada*, 911 F.2d 705, 15 USPQ2d  
1655 (Fed. Cir. 1990)). The corollary of this rule is that the absence from a cited  
§102 reference of any claimed element negates the anticipation. (*Kloster*  
*Speedsteel AB, et al v. Crucible, Inc., et al*, 793 F.2d 1565, 230 USPQ 81 (Fed. Cir.  
1986)). Furthermore, "[a]nticipation requires that all of the elements and limitations  
of the claims are found within a single prior art reference." (*Scripps Clinic and*  
*Research Found. v Genetech. Inc.*, 927 F.2d 1565, 1576, 18 U.S.P.Q.2d 1001, 1010  
(Fed. Cir. 1991 (emphasis added))). Moreover, the PTO and the Federal Circuit

1 provide that §102 anticipation requires that there must be no difference between the  
2 claimed invention and the reference disclosure. (*Scripps Clinic and Research Found.*  
3 *v. Genetech, Inc.*, id. (emphasis added)).

4 Accordingly, if the Applicant can demonstrate that any one element or  
5 limitation in claims 1-2, 5-8, 10-13 and 16-17 is not disclosed by Shima, then the  
6 respective claim(s) must be allowed.

7 In the following arguments, the Applicant will focus in particular on  
8 independent claims 1 and 12, as the Applicant believes those claims to be allowable  
9 over Shima. It is axiomatic that any dependent claim which depends from an  
10 allowable base claim is also allowable, and therefore the Applicant does not believe  
11 it is necessary to present arguments in favor of each and every dependent claim.  
12 The fact that Applicant has not presented herein specific arguments in favor of the  
13 allowability of each and every dependent claim which depends from arguably  
14 allowable independent claim is not to be considered as an admission that the  
15 dependent claims are only allowable as a result of their dependence on an allowable  
16 base claim, but rather as a matter of efficiency in responding to the instant Office  
17 action. The Applicant makes no concession nor admission that any dependent claim  
18 is allowable based solely on its dependence from an allowable base claim.

19 Claim 1:

20 The Applicant contends that independent claim 1, and rejected claims 2, 5-8,  
21 10-11 that depend therefrom, are not anticipated by Shima. Claim 1 (as amended)  
22 recites:

23 A method for printing N collated copies of a document on a printer, N being an  
24 integer greater than one, the method comprising:

25 determining whether the printer has capacity to print N collated  
copies of the document at a computer system separate from the  
printer, and

if the printer has insufficient capacity, then performing the following  
step N times:

sending a single copy of the document to the printer from  
the computer system.

(Emphasis added.)

1 Support for the amendment to claim 1 is provided in the specification at page  
2 4, lines 27-29 and Fig. 1 (element 120). The Office action first claims that Shima  
3 discloses "a method for printing N collated copies of a document on a printer, N  
4 being an integer greater than one." However, Shima never discloses, teaches or  
5 even suggests that the step of "determining whether the printer has capacity to print  
6 N collated copies of the document" is performed "at a computer system separate  
7 from the printer," as is required by Applicant's claim 1 (as amended). Furthermore,  
8 Shima never discloses, teaches or even suggests "sending a single copy of the  
9 document to the printer from the computer system" "if the printer has insufficient  
10 capacity," as is also required by Applicant's claim 1 (as amended). Instead, Shima  
11 discloses a printer (Fig. 1, 11) that includes components such as an interface (12),  
12 an interpretation section (13), a print request manager (14), an engine control  
13 section (15) and a print engine (16) (col. 11, lines 28-31). Shima teaches that the  
14 print request manager (14) comprises a storage section (21) that is provided with 3  
15 queues: an execution queue, a wait queue and a collation queue (col. 12, lines 19-  
20, 30-47). Shima is directed to various methods for moving a print request from  
one queue to another to free up memory blocks in the storage section (col. 12, lines  
48-62).

16 For at least these reasons, the Applicant contends that Shima does not  
17 anticipate Applicant's claim 1 (as amended).

18 The 35 U.S.C. § 102 rejection of claim 1 (as amended) is thus unsupportable  
19 in view of the requirements for such a rejection as described above. Thus, the  
20 Applicant contends that claim 1 (as amended) is allowable. As claim 1 (as  
21 amended) is allowable, claims 2, 5-8, 10-11 are allowable by virtue of their  
dependence upon an allowable base claim, as well as their own respective merits.

#### 22 Claim 12:

23 The Applicant contends that independent claim 12, and rejected claims 13, 16  
24 and 17 that depend therefrom, are not anticipated by Shima. Claim 12 (as  
25 amended) recites:

A computer readable medium on which is embedded a computer program,  
the program comprising one or more instructions for performing a method

1 of printing N collated copies of a document on a printer, N being an integer  
2 greater than one, the method comprising:

3 determining whether the printer has capacity to print N collated  
4 copies of the document ***at a computer system separate from the***  
5 ***printer***; and

6 if the printer has insufficient capacity, then performing the following  
7 step N times:

8 sending a single copy of the document to the printer ***from***  
9 ***the computer system***.  
(Emphasis added.)

10 Support for the amendment to claim 12 is provided in the specification at least  
11 at page 4, lines 27-29 and in Fig. 1 (element 120). The Office action claims that  
12 Shima discloses "computer readable medium on which is embedded a computer  
13 program, the program comprising one or more instructions for performing a method  
14 for printing N collated copies of a document on a printer, N being an integer greater  
15 than one." However, as described above with reference to claim 1, Shima never  
16 discloses, teaches or even suggests that the step of "determining whether the printer  
17 has capacity to print N collated copies of the document" is performed "***at a computer***  
18 ***system separate from the printer***," as is required by Applicant's claim 12 (as  
19 amended). Furthermore, Shima never discloses teaches or even suggests "sending  
20 a single copy of the document to the printer ***from the computer system***" "if the  
21 printer has insufficient capacity," as is also required by Applicant's claim 12 (as  
22 amended). As discussed above, Shima instead discloses a ***printer*** (Fig. 1, 11) that  
23 includes an interface (12), an interpretation section (13), a print request manager  
24 (14), an engine control section (15) and a print engine (16) (col. 11, lines 28-31).  
25 Shima teaches that the print request manager (14) comprises a storage section (21)  
that is provided with 3 queues including an execution queue, a wait queue and a  
collation queue (col. 12, lines 19-20, 30-47). Shima teaches methods for moving a  
print request from one queue to another to free up memory blocks in the storage  
section in order to effect collation printing (col. 12, lines 48-62).

For at least these reasons, the Applicant contends that Shima does not  
anticipate Applicant's claim 12 (as amended).

1 The 35 U.S.C. § 102 rejection of claim 12 (as amended) is thus unsupportable  
2 in view of the requirements for such a rejection as described above. Thus, the  
3 Applicant contends that claim 12 (as amended) is allowable. As claim 12 (as  
4 amended) is allowable, claims 13, 16-17 are allowable by virtue of their dependence  
5 upon an allowable base claim, as well as their own respective merits.

6 Rejection of Claims under 35 U.S.C. § 103(a)

- 7 • Claims 3-4, 9 and 14-15 have been rejected under 35 U.S.C. § 103 as being  
8 unpatentable over Shima in view of U.S. Patent Application 5,087,979 to  
9 Schaertel (hereafter, "Schaertel").
- 10 • Claims 18-20 have been rejected under 35 U.S.C. § 103 as being  
11 unpatentable over Schaertel in view of U.S. Patent No. 5,528,734 to Sanchez  
12 (hereafter, "Sanchez").

12 Claims 3-4, 9 and 14-15:

13 The Applicant respectfully disagrees that claims 3-4, 9 and 14-15 are obvious,  
14 due to the allowability of respective base claims 1 and 12, as argued above. It is  
15 axiomatic that any claim which depends from an allowable base claim is also  
16 allowable, for at least the reasons that the base claim is allowable, and therefore  
17 claims 3-4, 9 and 14-15 are allowable for at least the same reasons that respective  
18 claims 1 and 12 are allowable over Shima. Further, Schaertel does not cure the  
19 deficiency in Shima, as Schaertel does not teach or suggest the limitations of claims  
20 1 and 12 that are described above as missing from the teachings of Shima. The  
21 Applicant therefore requests that the rejection of claims 3-4, 9 and 14-15 be removed  
22 and the claims allowed.

21 Claims 18-20:

22 The Applicant contends that claims 18-20 are not obvious over Schaertel in view  
23 of Sanchez for at least the following reasons.

23 As a starting point, MPEP 706.02(j) states:

24 "[t]o establish a *prima facie* case of obviousness, three basic  
25 criteria must be met. First, there must be some suggestion or  
motivation, either in the cited references themselves or in the knowledge  
generally available to one of ordinary skill in the art, to modify the  
reference or to combine the reference teachings. Second, there must be

1 a reasonable expectation of success. Finally, the prior art reference (or  
2 references when combined) **must teach or suggest all the claim**  
3 **limitations**. The teaching or suggestion to make the claimed combination  
4 and the reasonable expectation of success must both be found in the  
5 prior art and not based on applicant's disclosure." (Emphasis added.)

6 In the following arguments, the Applicant will focus in particular on  
7 independent claim 18, as the Applicant contends that claim 18 is allowable over  
8 Schaertel in view of Sanchez. It is axiomatic that any dependent claim which  
9 depends from an allowable base claim is also allowable, and therefore the Applicant  
10 does not believe it is necessary to present separate arguments in favor dependent  
11 claims 19 and 20. Claim 18 recites:

12 An apparatus for processing an incoming print job requesting N collated  
13 copies of a document on a printer, N being an integer greater than one,  
14 the apparatus comprising:

15 a memory configured to store the document;

16 **a spooler**, connected to the memory, configured to send an  
17 outgoing print job to the printer;

18 **a status agent** configured to receive from the printer information  
19 regarding whether the printer has sufficient capacity to collate the  
20 document; and

21 **a control logic**, connected the spooler and the status agent, the  
22 control logic controlling the spooler on the basis of the information  
23 regarding whether the printer has sufficient capacity to collate the  
24 document.

25 (Emphasis added.)

26 As stated above, in order to maintain a rejection under 35 U.S.C. § 103(a), the  
27 prior art reference (or references when combined) **must teach or suggest all the**  
28 **claim limitations**. The Examiner states that Schaertel discloses a "**status agent**,"  
29 and refers to "buffer memory 58" to support this conclusion. The Applicant disagrees  
30 with this characterization of Schaertel. In fact, Schaertel does not teach a "**status**

1 agent", such as that described by the Applicant's disclosure. In fact, the "status  
2 agent" of Applicant's disclosure is nothing like a "buffer memory." According to the  
3 Applicant's disclosure "[t]he spooler 320 and the status agent 340 are preferably  
4 subprograms called by the control logic 330" and the "status agent" "performs the  
5 testing step 230 to determine memory status of the printer 110." (Applicant's  
6 specification, page 8, lines 2-3 and 8-9; emphasis added.) The Examiner relies on  
7 Sanchez to cure the deficiencies of Schaertel by asserting that "Sanchez discloses a  
8 control logic, connected the spooler and the status agent, the control logic  
9 controlling the spooler on the basis of the information regarding whether the printer  
10 has sufficient capacity to collate the document." (Emphasis added.) In fact, Sanchez  
11 does not teach that a "control logic control[s] the spooler on the basis of the  
12 information regarding whether the printer has sufficient capacity to collate the  
13 document," as is required by Applicant's claim 18. Rather, Sanchez discloses an  
14 "assigned disk" (col. 6, lines 1-22, Fig. 1, 114-I to 114-N) that is not located in the  
15 printer (Fig. 1, 24), but rather is located within a computer system (Fig. 1, 10). Since  
16 Sanchez does not disclose, teach or even suggest that a capacity of a printer affects  
17 "control logic" to "control[s] the spooler on the basis of the information regarding  
18 whether the printer has sufficient capacity to collate the document," Sanchez fails to  
19 correct the deficiencies of Schaertel. Therefore, a rejection of claim 18 under 35

20 U.S.C. § 103(a) is improper, since the prior art reference (or references, when  
21 combined) do not teach or suggest all of the claim limitations. Accordingly,  
22 Applicant respectfully requests withdrawal of the 35 U.S.C. § 103(a) rejection of  
23 claims 18-20.

24 Further, as stated above, in order to maintain a rejection under 35 U.S.C. §  
25 103(a), the **teaching or suggestion to make the claimed combination** and the  
reasonable expectation of success must both be found in the prior art and not  
based on Applicant's disclosure. However, the Office action does not indicate  
any suggestion or motivation in the prior art of record, either explicit or  
otherwise, for modifying the references or combining the references in a manner  
that would achieve the claimed invention, or even point out any teaching as to how  
such a modification or combination might be accomplished, or what might be  
accomplished by such a combination that is even relevant to Applicant's claim 18.

1 The Examiner alleges that "it would have been obvious to one of ordinary skill  
2 in the art at the time of the invention to modify Schaertel wherein a base logic  
3 program would be implemented to assist with a printer component could correlate  
4 with the memory insufficiency based on the communication from the printer's internal  
5 components" and that "[t]his feature permits uninterrupted data process and prevents  
6 data loss." (Office action, page 9.) However the topic of "uninterrupted data process  
7 and prevent[ing] data loss" occurs nowhere in Applicant's specification or claims. In  
8 fact, Applicant's claim 18 has nothing to do with "permit[ting] uninterrupted data  
9 process and prevent[ing] data loss," but rather is directed to "an apparatus for  
10 processing an incoming print job requesting N collated copies of a document on a  
11 printer." Therefore, this statement is merely conclusory, as it does not provide the  
12 necessary support for the motivation to make the combination, and does not point to  
13 any teaching to make the combination. Further, the Applicant contends that the  
14 references contain no such teaching, suggestion or motivation to combine the  
15 references in the manner indicated to arrive at Applicant's claim 18.

16 The Examiner has failed to support this rejection, instead merely repeating  
17 Applicant's claim language, which is based on Applicant's own teachings, and then  
18 contending that these claims are obvious. Such broad conclusory statements,  
19 standing alone, are not evidence of obviousness. The Applicant thus challenges this  
20 unsupported statement, and specifically requests that the claim rejection based on  
21 this statement be withdrawn, or alternately, that the Examiner submit a reference or  
22 references in support of the rejection, including a motivation to combine Schaertel  
23 with Sanchez in a manner that would reach the claimed subject matter. (See  
24 MPEP § 2144.03.) The Applicant therefore respectfully submits that the rejection of  
25 claims 18-20 is improper, and requests that the rejection be withdrawn. Allowance of  
claim 18 is therefore respectfully requested. Claims 19-20 depend from claim 18,  
and Applicant contends that claims 19 and 20 are allowable for at least the reasons  
described above with reference to claim 18.

#### Summary

The Applicant believes that this response constitutes a full and complete  
response to the Office action, and therefore requests timely allowance of claims 1  
through 20.

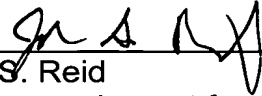
S/N: 09/728,690  
Case 10001726-1  
Amendment "A"



1 The Examiner is respectfully requested to contact the below-signed  
2 representative if the Examiner believes this will facilitate prosecution toward  
3 allowance of the claims.

4  
5 Respectfully submitted,  
6 Shell S. Simpson

7 Date: December 23, 2005

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